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**C. REMARKS****Summary of the Claims**

Claims 1-7 and 9-19 are currently pending in the application. Claims 1, 9, and 13 are independent claims. No claims have been amended, added, or cancelled. Reconsideration of the claims is respectfully requested.

**Examiner Discussions**

The current Office Action suggests that an Examiner Interview would be helpful because the Examiner believes that the claim language claims Applicants' invention rather broadly. Applicants attorney scheduled an interview with the Examiner but, unfortunately, the Examiner needed to cancel the scheduled interview and scheduling conflicts prevented scheduling another interview before the due date. Applicants note, however, that previous Examiner interviews were conducted on June 16, 2003 and on February 24, 2004.

In addition, Applicants note that the claims of Applicants' invention have been substantially refined to distinctly claim Applicants' invention. Applicants respectfully disagree with the Examiner's assertion that Applicants' claims, as currently presented, are "too broad." This simply is not the case. Applicants' disagreement is buttressed by the alleged prior art that the Examiner is currently using to reject Applicants' claims. As Applicants' attorney briefly described when the Examiner called to cancel the scheduled Interview, the Microsoft Windows 3.1 reference falls considerably short of teaching each and every element of Applicants claims. Applicants have set forth these considerable differences in detail below. As result of these differences, Applicants respectfully request allowance of Applicants' remaining claims.

**Claim Rejections 35 U.S.C. § 112**

Claims 1-7 and 9-19 were rejected under 35 U.S.C. § 112 for failing to comply with the written description requirement. In particular, the term "non-spatially distinguishable" added to claims 1, 2, 6, 9, 10, 11, 13, 14, and 18 was not specifically used in the specification. Applicants respectfully remind the Examiner that this

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limitation was discussed in a previous Examiner Interview in order to further distinguish Applicants' claimed invention from art previously cited by the Examiner in a previous Office Action. Evidently this suggestion was based upon a visual comparison of Applicants' drawings where objects are distinguished on factors other than their spatial proximity to one another. Ample support for "non-spatially distinguishable" objects is found in Applicants' original drawings filed with the Application (see Figures 1 and 2). In addition, Applicants have amended the specification and added the term "non-spatially distinguishable" as it relates to the objects shown in Figures 1 and 2. As the objects were shown as being non-spatially distinguishable in Applicants' original drawings, no new matter has been added as a result of this Amendment.

**Claim Rejections 35 U.S.C. § 102**

The Office Action mailed January 11, 2005 rejected claims 1-7 and 9-19 as being anticipated, and therefore unpatentable, over a chapter from a book entitled *Mastering Windows 3.1 Special Edition*, by Sybex (hereinafter "MW3"). The rejections of these claims is respectfully traversed.

As an initial matter, the Office Action rejected Applicants' claims under 35 U.S.C. § 102(b). However, no copyright or publication date appears on the photocopied materials provided to Applicants accompanying the Office Action. Therefore, Applicants are unable to ascertain whether the cited reference is in fact prior art to Applicants' claimed invention. As discussed below, the MW3 reference falls considerably short of teaching each and every reference of Applicants' claims. Nonetheless, Applicants reserve the right to further challenge the applicability of the MW3 reference in any future Responses and/or Appeals. If, after consideration of Applicants remarks herein, the Examiner wishes to maintain the rejection of any of Applicants' claims under the MW3 reference, then Applicants respectfully request a proper showing that the MW3 reference is indeed prior art to Applicants claimed invention (i.e., providing a copy of a page from the reference that shows any and all applicable publication dates).

MPEP § 2131 provides that in order to anticipate a claim, the reference must teach every element of the claim. Specifically, MPEP § 2131 states (emphasis added):

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

Applicants respectfully assert that the cited references simply fail to teach each and every element as set forth in Applicants' claims.

Each of Applicants' independent claims is directed at displaying layered data and includes the limitations of:

- selecting one or more objects to be displayed in a plurality of layers;
- identifying a plurality of non-spatially distinguishable display attributes, wherein one or more of the non-spatially distinguishable display attributes corresponds to each of the layers;
- matching each of the objects to one of the layers;
- applying the non-spatially distinguishable display attributes corresponding to the layer for each of the matched objects;
- determining a layer order for the plurality of layers, wherein the layer order determines a display emphasis corresponding to the objects from the plurality of objects in the corresponding layers; and

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- displaying the objects with the applied non-spatially distinguishable display attributes based upon the determination, wherein the objects in a first layer from the plurality of layers are visually distinguished from the objects in the other plurality of layers based upon the non-spatially distinguishable display attributes of the first layer.

The MW3 reference is a chapter directed towards teaching the File Manager that was used to display directories and files within directories in older versions of the Microsoft Windows operating system. The version of the File Manager shown in MW3 is that included with the Windows 3.1 operating system. The Windows 3.1 operating system was an operating system offered prior to the release of Windows 95™ in 1995.

The Office Action contends that the MW3 reference shows “selecting one or more objects to be displayed in a plurality of layers” and explains that the subdirectories are the “layers” and the selection of the “one or more objects” (i.e., subdirectories) is performed by selecting “a root directory object.” Next, the Office Action contends that MW3 shows “identifying a plurality of non-spatially distinguishable display attributes, wherein one or more of the non-spatially distinguishable display attributes corresponds to each of the layers” because the MW3 reference shows different icons corresponding to files within the various directories (citing pages 112 and 113). However, as one of skill in the art appreciates, various files reside within any given subdirectory, so the icons within a particular directory cannot be used to differentiate one subdirectory from another because each may have the same files. In fact, Figure 4.4 appearing on page 112 of MW3 shows exactly that – several different file types (icons) within the directory being shown. Therefore, the display attributes taught by MW3 (the various icons) simply cannot be used to differentiate between the various layers (subdirectories).

The Office Action contends that the MW3 reference teaches “determining a layer order for the plurality of layers, wherein the layer order determines a display emphasis corresponding to the objects from the plurality of objects in the corresponding layers,” citing Figure 4.2 shown on page 105. The Office Action has associated “directories” with Applicants’ “layers” and files within a directory as Applicants’ “objects.”

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Applicants note that no files ("objects") are even shown in Figure 4.2 on page 105. Objects (files) for one layer (subdirectory) are shown in Figure 4.4 on page 112, however no "display emphasis" is taught or suggested so that the objects in the selected directory (layer) are distinguished from objects in another directory. In order to anticipate Applicants' claimed limitation, the MW3 reference would need to teach or suggest displaying objects (files) from a plurality of layers (subdirectories) in a way such that objects (files) in one of the layers (subdirectories) are visually distinguished from objects (files) in the other layers (subdirectories).

Finally, it appears that Applicants' claimed limitation of "displaying the objects with the applied non-spatially distinguishable display attributes based upon the determination, wherein the objects in a first layer from the plurality of layers are visually distinguished from the objects in the other plurality of layers based upon the non-spatially distinguishable display attributes of the first layer" is not even discussed in the Office Action. As previously mentioned, in order for a reference to anticipate Applicants' claimed invention, it must teach each and every claimed limitation. The Office Action does not even contend that the MW3 reference teaches Applicants last two limitations, and indeed, upon closer review, it is apparent that the MW3 reference falls far short of teaching or suggesting these limitations. As pointed out in the preceding paragraph, Figure 4.2 on page 105 does not even show displaying both layers (subdirectories) and objects (files). Applicants note that the File Manager software within Windows 3.1, as taught by MW3, can show the objects (files) within a single layer (subdirectory), as shown in Figure 4.4 on page 112. However, no where does MW3 teach or suggest displaying a plurality of objects (files) from a plurality of layers (subdirectories) in a manner such that objects in one layer are visually distinguished from objects in the other layers using non-spatially distinguishable display attributes.

Applicants note that the Office Action does not detail rejections of any of Applicants dependent claims. In addition, Applicants respectfully direct the Examiner's attention to MPEP § 707.07(g) which indicates that "piecemeal" examination should be avoided as much as possible and directs the Examiner to reject each claim on all valid grounds. As only the limitations of Applicants' independent claims were discussed in the

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Office Action, each of Applicants' dependent claims is assumed to be allowable over MW3 as the Office Action fails to indicate otherwise. MPEP § 707.07(g) states as follows:

**707.07(g) Piecemeal Examination**

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and res judicata should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

(A) Where an application is too informal for a complete action on the merits. See MPEP § 702.01;

(B) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination. See MPEP § 2173.05(n);

(C) Where there is a misjoinder of inventions and there has been no successful telephone request for election. See MPEP § 803, § 806.02, § 812.01;

(D) Where disclosure is directed to perpetual motion. See *Ex parte Payne*, 1904 C.D. 42, 108 O.G. 1049 (Comm'r Pat. 1903). However, in such cases, the best prior art readily available should be cited and its pertinency pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of res judicata, no prima facie showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accompanied by rejection on all other available grounds.

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Claims 2-7 each depend, directly or indirectly, on claim 1 and, therefore, are each allowable over MW3 for at least the same reasons that claim 1 is allowable over MW3. Likewise claims 10-12 and 14-19 are each dependent, directly or indirectly, on claims 9 and 13, respectively, and are allowable over MW3 for at least the same reasons that their respective independent claims are allowable.

**CONCLUSION**

As a result of the foregoing, it is asserted by Applicants that the amended claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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